

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Jerding, Dean F., et al

Serial No.: 09/590,434

Filed: June 9, 2000

Group Art Unit: 2623

Examiner: Beliveau, Scott E.

Docket No. 191910-1480

For: **Information Caching System and Method**

REPLY BRIEF

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Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is a Reply Brief in response to an Examiner's Answer filed by Examiner Scott E.

Beliveau, sent on *March 7, 2007*

I. STATUS OF THE CLAIMS

Claims 134 – 138 are pending in the application. The Examiner's Answer maintains the rejections of claims 134 – 138, and generally repeats the arguments advanced during prosecution of this application along with providing comments to the Appeal Brief. With regard to the substantive remarks of the Examiner's Answer, Appellants disagree. Appellants will address some issues raised in the Examiner's Answer. Appellants continue to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

II. ARGUMENTS

A. Drawings Objection

The Examiner's Answer reiterates an objection to the drawings of the Instant Application, first raised in the Advisory Action dated 7/26/06. More specifically, in footnote 3, on page 12, the Examiner's Answer states:

[t]he Final Rejection objected to the drawings as not showing the claimed feature of distinctive 'rental options' (ex. separate buttons). Applicant traversed the objection on the grounds that it was not necessary for the understanding of the invention... The examiner inquired... whether it was not necessary because it should be considered 'conventional'. Appellants have not commented on this inquiry to date.

Appellants do not consider the referenced portions to be conventional. Appellants merely asserted that for a proper understanding of the Instant Application and currently pending claims, illustration of each and every feature in each and every embodiment (including the referenced portions of the application) need not be represented in the drawings. The referenced portions of the specification are clearly described in the written description and, thus, inclusion in the drawings is unnecessary. Pursuant to 37 C.F.R. §1.81, which states "[t]he Applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be

patented,” Appellants respectfully submit that inclusion of the disputed portions of the specification into the drawings is unnecessary.

B. Claim Rejections

1. Claim 134 is Allowable

With regard to claim 134, the Examiner’s Answer asserts that either the first option and the second option are allegedly the same option or the specification allegedly does not support the claim. More specifically, the Examiner’s Answer states “[s]eparate ‘first’ and ‘second rental option’ are not disclosed in the application” (page 12, line 1). The Examiner’s Answer then cites a paragraph of the specification that includes a description of an exemplary embodiment of the claimed “first rental option” and “second rental option.” More specifically, the Examiner’s Answer cites the following:

As another rental option, the user may select to view a MOD title without any promotional advertising. As a non-limiting example, a user, upon selecting such an option, may view a MOD title without any movie trailers commonly shown in movie theaters prior to the feature presentation. As another non-limiting example the MOD title may be presented to the user without any advertising logos, brands, or other marks that might otherwise be included in the presentation of the MOD title.

(Page 12, line 5 – citing IA page 21, line 28).

However, in the very next paragraph, the Instant Application states:

A MOD application server 19 graphical user interface (GUI) allows the system operator to **define any number of rental options such as those mentioned above**. Defined in the catalog is the information about **each rental option**: description, price, VOD stream control mechanisms enabled, **trailers enabled, advertising enabled**, etc. such that the MOD application client 65 can enforce the chosen rental option for a title.

(**Emphasis added** – IA page 21, line 33)

As illustrated in this passage, the Instant Application defines separate and distinct options, such as those described, beginning page 21, line 28, and included in claim 134. As such, Appellants submit that one of ordinary skill in the art would consider the Instant Application to clearly disclose separate options as described in claim 134. Consequently, it is clear that a reasonable interpretation of the specification supports the

“first rental option” and the “second rental option” as recited in claim 134 as separate and distinct options.

Appellants further assert that the Examiner’s Answer (and previous Office Actions) have simply failed to provide references (individually or in combination) that disclose, teach, or suggest a “television set-top terminal (“STT”) coupled to a server via a bi-directional communication network, said STT comprising... at least one processor that is programmed by the program code to enable the STT to... configure **a first rental option** in the plurality of user-selectable rental options to provide a user-selectable option to **view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation** of the user-selected on-demand rentable video presentation... [and] configure **a second rental option** in the plurality of user-selectable rental options to provide a user-selectable option to **view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation** of the user-selected on-demand rentable video presentation” as recited in claim 134. Appellants respectfully submit that because the Examiner’s Answer has failed to provide references that disclose each and every feature of claim 134, the Examiner’s Answer attempts to unreasonably limit the teachings of the specification to overcome this deficiency. For at least this reason, Appellants respectfully request allowance of claim 134.

2. Claims 135 – 138 are Allowable

Appellants respectfully submit that dependent claims 135 – 138 are allowable, as a matter of law, for at least the reason that these claims depend from allowable independent claim 134. Appellants additionally submit that there are other, independent reasons that claims 135 – 138 are allowable, but do not address these reasons at this time.

III. CONCLUSION

Based upon the foregoing discussion, Appellants respectfully request that the Examiner's final rejection of claims 134, 135, and 136 – 138 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

No additional fee is believed to be due. However, any additional fee that may be due or required is authorized to be charged to deposit account no. 20-0778.

Respectfully submitted,

/afb/
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